



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,219	11/03/2003	Patricia V. Kempton	132006-0002	3089

24267 7590 04/29/2005

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

e

Office Action Summary	Application No. 10/700,219	Applicant(s) KEMPTON, PATRICIA V.	
	Examiner Faye Francis	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-9 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Newly submitted claim 10 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally elected inventions (invention I) and the invention of claim 10 (invention II) are distinct, each from the other because they are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. For example the product recited in claim 1-9 can be used without the step of gently grasping the child's injured area while wearing the puppet to provide hot or cold therapy, by placing the pouch of the puppet over an injury of said child as recited in claim 10.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The amendment filed 2/28/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a portion of the puppet

may be comprised of a material that allows temperature transfer of the hot or cold through the pouch area in line 6-7 of page 5.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 2 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from the specification how a temperature transferring material as required in claim 2 can be incorporated into the claimed apparatus since it appears from the specification that the temperature transferring material and the removable element as recited in claim 1 are the same element therefore, additional structure as claimed in claim 2 can not be determined since according to the specification as originally filed the only object within the pouch is the removable element.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Frye [US 4,694,829].

Frye discloses in Figs 1-2, a hand puppet comprising: the puppet having a body portion [outer member 7], a head portion [Fig 1], a pouch [pocket 18] disposed in the body portion of the puppet, a removable element [envelope/container 10 containing the non-toxic liquid 11 or solid particulate material which is made out of flexible material[col 3 lines 1-6]] receivable within the pouch that is capable of providing a cold or heat therapy [col 3 lines 43-46] to a body portion of a child as recited in claim 1. Additionally, Frye discloses the head portion is an animal shape [Fig 1] as recited in claim 3, the head portion is a character shape [Fig 1] as recited in claim 4 and the removable element is an ice pack [the liquid within the container 10 is inherently cable of being freezed into ice when it is used as a cold compress and re-freezed] as recited in claims 5-6.

With respect to the limitation "hand puppet", device of Frye is inherently capable of being considered as a hand puppet or used as a hand puppet since for example, an adult can insert his/her hand [some adult's hands are smaller than a child's hand] into the pouch [pocket 18] via the opening 17 in order to manipulate the device while the pouch is contiguous to the palm of the adult's hand. Therefore, the requirement for the hand puppet as broadly as claimed does not distinguish over the prior art.

Furthermore, the use of "adapted to" in line 4 of claim 1 makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is "adapted to" to perform a function only requires the ability to

Art Unit: 3728

so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In this case the device of Frye is capable of to being worn on the hand of an adult by the hand being inserted therein allowing grasping or cuddling of an injured area on the child whereby manipulation of the adult's hand causes manipulation of the puppet.

7. Claim 9 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Van Winkle et al [US 5,584,086], herein after Van Winkle.

Van Winkle discloses in the embodiment of Fig 8, a hand puppet comprising: a body portion [pad 30] adapted for insertion of a person's hand therein, the body portion containing at least one finger portion [the reference discloses that it can be in the shape of a hand [col 4 line 50]], a pouch [pocket 32] disposed in the body portion and a removable element [filling 18].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Frye as applied to claims 1-6 above and further in view of Hodges [US 5,507,793].

Frye discloses most of the elements of this claim but for the removable element being an air-activated device.

Hodges is cited to show desirability, in the relevant art, to use an air activated heating pad [heat transfer unit U], which is inserted within a pouch [pocket 16a] in order to provide heat therapy. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the movable element in the device of Frye to include the air activated heating pad as taught by Hodges in order to maintain, upon exposure to air, an even temperature for approximately ten hours.

10. Claims 1-4 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Van Winkle.

Van Winkle discloses in the embodiment of Fig 7, a teddy bear-shaped device having a body portion, a head portion, a pouch [inner cover 16] disposed in the body portion of the device, a removable element [filling 18] receivable within the pouch that is capable of providing a cold or heat therapy [col 5 first paragraph] to a body portion of a child as recited in claim 1. Additionally, Van Winkle discloses the head portion is an animal shape [Fig 7] as recited in claim 3, the head portion is a character shape [Fig 7] as recited in claim 4.

Van Winkle may not disclose a hand puppet. However, Van Winkle discloses in the embodiment of Fig 8, a pad 30 having a pocket 32 to allow insertion of hands. It would have been obvious to modify the teddy bear-shaped device of Van Winkle to include the pocket to allow insertion of adult's hands therein [col 4 line 55] and inherently capable of being manipulated while the pouch is contiguous to the palm of the adult's hand. Therefore, the requirement for the hand puppet as broadly as claimed does not distinguish over the prior art.

Furthermore, the use of "adapted to" in line 4 of claim 1 makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is "adapted to" to perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In this case the device of Van Winkle is capable of to being worn on the hand of an adult by the hand being inserted therein allowing grasping or cuddling of an injured area on the child whereby manipulation of the adult's hand causes manipulation of the puppet in as much as the Van Winkle in the embodiment shown in Fig 8 discloses a device having a pocket to allow insertion of hand therein.

11. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Van Winkle as applied to claims 1-4 and 7 above and further in view of Hodges.

Van Winkle discloses most of the elements of this claim but for the removable element being an activated device.

Hodges is cited to show desirability, in the relevant art, to use an air activated heating pad [heat transfer unit U], which is inserted within a pouch [pocket 16a] in order to provide heat therapy. It would have been obvious to modify the movable element in the device of Van Winkle to include the air activated heating pad as taught by Hodges in order to maintain, upon exposure to air, an even temperature for approximately ten hours.

Response to Arguments

12. Applicant's arguments filed on 2/28/05 have been fully considered but they are not persuasive.

In response to applicant's argument in page 10 regarding, "the Frye patent does not utilize the word "puppet": this feature has already been addressed in paragraph 6.

In response to applicant's argument on page 10 that there is no suggestion in Frye that a person's hand could be **fully** inserted therein. Prior art applied by the examiner in a rejection of claims is not required to show that which is not claimed. It is well settled that features not claimed may not be relied upon in support of patentability. In re Self, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982). Additionally, the examiner takes the position that a person's hand could be **fully** inserted therein [some hands are smaller than the others].

In response to applicant's argument on page 11 regarding the rejection of claim 8, the examiner would like to point out that Hodges reference has been applied only to show that is to use an air activated heating pad which is inserted within a pouch in order to provide heat therapy is conventional.

In response to applicant's argument in page 12 regarding, "There is nothing in the Van Winkle patent which suggests a hand puppet which can be worn on the hand of a person", please see Van Winkle [col 4 line 54].

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3728

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF

A handwritten signature in black ink, appearing to read 'Derris H. Banks', is written over a horizontal line.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700